

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HOLOGIC, INC., and CYTYC SURGICAL
PRODUCTS, LLC,

Plaintiffs,

v.

MINERVA SURGICAL, INC.,

Defendant.

C.A. No. 15-1031-JFB-SRF

PLAINTIFFS' RESPONSE TO MINERVA'S NOTICE OF SUBSEQUENT FACTS

Plaintiffs Hologic, Inc. and Cytac Surgical Products, LLC (collectively, “Hologic”) respond to Minerva’s April 22, 2019 notice of subsequent facts. (D.I. 614.)

Minerva is incorrect when it argues that “Hologic no longer has ‘any cause of action based on [the ’183 patent] claim, and any pending litigation in which the claims are asserted becomes moot.’” (D.I. 614 at 1.) The Court rejected this very argument when it denied Minerva’s Motion to Dismiss: “[A] determination of patentability . . . occur[s] only after *all appeals* have terminated” and the “Patent Office cannot cancel claims of patents until after appeal.” (D.I. 407 at 31 (citing 35 U.S.C. § 318(b) and *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 645 (Fed. Cir. 2011).) Here, the appeal is not terminated, so the USPTO has not and cannot cancel any claims of the ’183 Patent. The time to file petitions for rehearing, reconsideration and/or certiorari has not expired and substantive decisions on those petitions may not issue until 2020.

More importantly, the cancellation of the patent, even assuming that had occurred, would not help Minerva avoid liability in this case due to assignor estoppel. *See Am. Fence Co. v.*

MRM Sec. Sys., Inc., 710 F. Supp. 37 (D. Conn. 1989); *AgroFresh Inc. v. Mirtech, Inc.*, C.A. No. 16-662-MN-SRF, D.I. 310 at 9 (D. Del. Nov. 28, 2018).

Both the applicability of assignor estoppel and the impact of the pending '183 Appeal on this litigation have already been fully briefed in the context of Minerva's Motion to Dismiss and Hologic's post-trial motions. (*See, e.g.*, D.I. 276 at 3-9; D.I. 291 at 19-20; D.I. 320 at 3-5; D.I. 323 at 3-6; D.I. 340 at 3-5; D.I. 533 at 17-18; D.I. 547 at 19; D.I. 567 at 10; D.I. 599 at 1-2; D.I. 604 at 1-3.) The additional briefing requested by Minerva in the form of "status reports" is unnecessary. Hologic is available for a telephonic status conference at the Court's convenience.

DATED: April 23, 2019

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CERTIFICATE OF SERVICE

I, Karen L. Pascale, Esquire, hereby certify that on April 23, 2019, I caused to be electronically filed a true and correct copy of the foregoing document with the Clerk of the Court using CM/ECF (which will send notification that such filing is available for viewing and downloading to all registered counsel), and in addition caused true and correct copies of the foregoing document to be served upon the following counsel of record by electronic mail:

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